

REMARKS

1. In response to paragraph 1 of the Office Action, Applicant acknowledges and appreciates Examiner's acceptance of its previous RCE and entry of its submission filed on November 13, 2007.
2. In response to paragraph 2 of the Office Action, Applicant acknowledges Examiner's pointing out that Applicant misnumbered its previously submitted new claims 22-41 because Applicant accidentally omitted any claim number 36. Applicant has amended its previously submitted claims 37-41 to claims 36-40, wherein a claim 36 now exists and amended for proper claim dependency for amended claims 37-40. Applicant requests entry of these amendments to correct the typographical misnumbering.
3. In response to paragraph 3 of the Office Action, Applicant acknowledges Examiner's rejection of all claims, namely claims 22-35 and 37-41, under 35 U.S.C. § 103 (a) as being rendered obvious by Bahar, U.S. Pub. No. 2002/0019852 A1 ("Bahar") in view of Massanelli *et al.*, U.S. Pub. No. 2004/0133645 A1 ("Massanelli"). Applicant objects with traverse to Bahar in view of Massanelli rendering obvious Applicant's claims 22-35 and 37-41.

The Supreme Court recently addressed the issue of obviousness in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). "While the KSR Court rejected a rigid application of the teaching, suggestion, or motivation test in an obviousness inquiry, the Court acknowledged the importance of identifying 'a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does' in an obviousness determination."¹ The *prima facie* case of obviousness still requires: 1) some suggestion or motivation in references or in knowledge of those skilled in the art to modify a reference, 2) that the references possess a reasonable expectation of success in the modification or combination, and 3) that the references must teach or suggest

¹ *Takeda Chemical Industries, Ltd., et al. v. Alphapharm Pty., Ltd et al.*, 2007 U.S. App. LEXIS 15349, *12-13 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. at 1731 (2007)).

all of Applicant's claim elements and limitations.² Below, Applicant shows that Bahar, even in view of Massanelli, does not render obvious Applicant's claims 22-35 and 37-41.

Claim 22 states: A method in a data processing system for selectively transmitting an email attachment of an email, the method comprising:

selecting, by a sender, email attachment recipients, selectable notification recipients, and excluded recipients for the email to be sent, wherein the excluded recipients do not receive the email attachment;

receiving, from the sender, an instruction to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients;

transmitting the email to the email attachment recipients, the selectable notification recipients, and the excluded recipients; and

receiving the email attachment by both the selectable notification recipients, who activated the selectable notification, and the email attachment recipients.

Bahar teaches or suggests "confirming proper receipt of an email file" "delivered to a recipient email address and stored in a data storage location", wherein an "accessing party, who may or may not be the intended target party" "accesses the email file . . . or user account" and "various recipient information" aimed solely at probing *identity* information about the recipient is "included in a generated confirmation of receipt notice" to the sender, wherein "the accessing party" may "in many cases" "be unwilling to cooperate with the sending party in returning a confirmation of recipient reply." See Bahar, Abstract, ¶ 35. The "confirmation of receipt notice" contains "recipient data" obtained and discovered "by searching . . . in target locations . . . such as the recipient system". See Bahar, ¶ 35. "Discovering or obtaining the identity of the individual actually causing the access event would be particularly advantageous." *Id.* "[I]dentification verification for access . . . would be used in conjunction with the present invention." *Id.* In sum, Bahar is akin to automatically sending cookies, *i.e.*, identity information, in a "confirmation of receipt notice" to the sender of an email at an email address, and after an "accessing party", who Bahar says

² MPEP § 2142; *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

may or may not be the intended recipient of the email, accesses the email “stored in a data storage location.” See Bahar, Abstract, ¶ 35.

Applicant respectfully submits that Bahar fails to render obvious Applicant’s independent claim 22 because Bahar does not teach or suggest any of Applicant’s claim elements and limitations as asserted at page 3 of the Office Action.³ First, as just shown for example in the preceding paragraph, Bahar does not teach or suggest Applicant’s claimed “selecting, by a sender ... “selectable notification recipients, and excluded recipients for the email to be sent, wherein the excluded recipients do not receive the email attachment.” Bahar has *no* selection occurring by anyone, including the sender, of “*selectable notification recipients*” or “*excluded recipients*”. Second, as just shown, Bahar does not teach or suggest Applicant’s claimed “receiving, from the sender, an instruction to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients.” Bahar has no receipt, by anyone, including “from the sender” of “an instruction to add a selectable notification” “to the email to be sent to the selectable notification recipients.” Third, as just shown, Bahar does not teach or suggest Applicant’s claimed “transmitting the email to ... the selectable notification recipients, and the excluded recipients.” Bahar does not transmit the email to *different classes* of recipients, such as “selectable notification recipients” and “excluded recipients.” Instead and quite dissimilarly, Bahar singularly attempts to deliver emails to same class of recipient, *i.e.*, the proper one, and glean identity of the recipient – this is clearly not what Applicant does. And, fourth, Bahar does not teach or suggest Applicant’s claimed “receiving the email attachment by both the selectable notification recipients, who activated the selectable notification.” Bahar does not teach or suggest that anyone receives “the email attachment” after having “activated the selectable notification.” In sum, Bahar fails to teach or suggest *any* of Applicant’s four claim elements and limitations for Applicant’s claim 22, as well as Applicant’s other independent claims 30 and 38 under the same analogy also used by the Office. Accordingly, any and all claims depending from independent claims 22, 30, and 38 are also not obvious as a matter of law.⁴ Therefore,

³ *Id.*

⁴ *Id.*; *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) (if independent claim is allowable, then so are the dependent claims).

Applicant respectfully requests withdrawal of all claim rejections under § 103(a) as a matter of law.

Although the above discussion already shows many reasons, when only one of these reasons is necessary, as to why Bahar fails to teach or suggest Applicant's claims to render them obvious, Applicant now provides additional or alternative reasons as to why Massanelli does not teach or suggest Applicant's claimed invention in view of Bahar. First, Applicant agrees with the Office that Bahar fails to teach or suggest "a system wherein the excluded recipients do not receive the email attachment being part of the selection process;" and further agrees that Massanelli does not teach what the Office claims Bahar teaches as a result of the Office's non-assertion otherwise, *i.e.*, a tacit admission by the Office that Massanelli does not teach what the Office claims Bahar teaches in the Office Action.

Second, Applicant disagrees that Massanelli teaches or suggests "a system wherein the excluded recipients do not receive the email attachment being part of the selection process." Massanelli teaches or suggests a "data center 104 backs-up the company email server 102 for audits, including recovery audits. *See* Massanelli, ¶ 20. "The email filtering module 122 may comprise computer-executable instructions for performing archiving, filtering, selection and extraction of email stored in the company email server 102." *See* Massanelli, ¶ 25. [emphasis added]. "[I]mmediately upon receipt by the company email server 102 the predefined selection criteria is **applied** against emails and email attachments." *See* Massanelli, ¶ 26, [emphasis added]. "Email and attachments satisfying the selection criteria are **copied and forwarded** to the data center where they are stored." *Id.*, [emphasis added] "This process seeks to **identify** only those emails and documents pertinent to the audit analysis." *See* Massanelli, ¶ 27, [emphasis added]. "The real-time or near real-time **capture and archive** implemented by the system of FIG. 1 will next be described with respect to FIG. 2" *See* Massanelli, ¶ 35, [emphasis added]. "[T]he email filtering module 122 may comprise a plug-in program that works with the company email server 102, or an email program (*e.g.*, Microsoft OutlookTM) operating therewith, to interrogate the **sent and received** electronic communications in real time or near real-time." *See* Massanelli, ¶ 36, [emphasis added]. "Using the plug-in or a like component, emails and attachments may be **compared** against

the selection criteria to filter the emails and attachments.” *See* Massanelli, ¶ 37, [emphasis added]. Here, it is clear that Massanelli does not teach or suggest “a system wherein the excluded recipients do not receive the email attachment being part of the selection process. That is, Massanelli teaches or suggests an email filtering module for comparing emails and email attachments based on selected criteria for emails and email attachments after being copied and forwarded to a data center for storage. Simply, and unlike Applicant, there is no teaching or suggestion in Massanelli of sending an email to one determined to be an excluded recipient, wherein such excluded recipient is determined to be a class of people not to receive an email attachment for an email *to be sent*. Furthermore, combining the teachings of Massanelli with Bahar would not result in Applicant’s claim invention. Accordingly, whether viewed alongside Bahar or not, Massanelli also fails to teach or suggest all elements and limitations of Applicant’s claim 22, as well as Applicant’s other independent claims 30 and 38 under the same analogy also used by the Office. Therefore, any and all claims depending from independent claims 22, 30, and 38 are also not obvious as a matter of law.⁵ Again, Applicant respectfully requests withdrawal of all claim rejections under § 103(a) as a matter of law.

⁵ *Id.*; *In re Finé*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(if independent claim is allowable, then so are the dependent claims).

CONCLUSION

Based on the foregoing, Applicant respectfully submits that the instant application is in condition for allowance. Applicant invites the Office to freely reach Applicant's attorney using the contact information found in his signature block below.

No fee is believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 09-0447 for any such required fee.

Respectfully submitted,

Date: June 17, 2008

/Erik J. Osterrieder/
Erik J. Osterrieder
Reg. No. 48,966
Schubert Osterrieder & Nickelson PLLC
6013 Cannon Mtn. Dr., S14
Austin, TX 78749
Tel: (713) 533-0494
Fax: (512) 301-7301
ATTORNEY FOR APPLICANT/ASSIGNEE